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MAR 30 2006

OFFICE OF PETITIONS

In re Application of :
Gerd WILSDORF :
Application No. 10/771,923 :
Filed: February 4, 2004 :
Attorney Docket No. 2001P16031WOUS :

ON PETITION

This is a decision on the petition under 37 CFR 1.183, filed March 20, 2006, seeking waiver of the rules where they require the surcharge of 37 CFR 1.17(t) as a component of a petition under 37 CFR 1.78(a)(3). This is also a decision on the petition under 37 CFR 1.78(a)(3), filed March 20, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §120 and 365(c) for the benefit of priority to the prior-filed PCT Application No. PCT/EP/008841, filed August 7, 2002 set forth in the concurrently filed Application Data Sheet.

The petitions are **DISMISSED**.

Petitioner requests waiver of the requirements of 37 CFR 1.78(a)(3) as it relates to the surcharge under 37 CFR 1.17(t) to perfect petitioners claim for priority or in the alternative to grant and charge a single fee required for such grant of priority in a plurality of applications, notwithstanding 37 CFR 1.4(c). Petitioner is filing this same petition in fifty other patent applications that were filed with the same error in claiming priority (i.e., indicating upon filing that the international application was a foreign priority claim, as opposed to a domestic priority claim) and believes that petitioner should treat these errors as a single error. Thus, petitioner believes that only a single \$1,370 surcharge fee under 37 CFR 1.17(t) or a \$400 petition fee should be required for the same error repeated fifty-one times.

35 U.S.C. 120 states:

An application for patent for an invention disclosed in the manner provide by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provide by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit to the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier

filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

37 CFR 1.78 states in part:

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending non-provisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

37 CFR 182 states:

All situations not specifically provide for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the director or director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f)

The issue at hand is not what actions petitioner has or has not taken in another patent application; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence herein. In the instant case, a review of the record indicates that this application was not filed as a 35 U.S.C. 371 application, but as a regular 35 U.S.C. 111(a) application. Therefore, it would not have been proper for the Filing Receipt to indicate that this application is a U.S. National Stage Filing of PCT/EP/08841. The originally filed Application Data Sheet only indicated a claim for priority of German application 10138888.8 filed August 8, 2001.

Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

However failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183. Furthermore, extraordinary relief will not be considered where the rules of practice already provide an avenue for relief. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Here, petitioner could have sought to obtain domestic priority by filing an appropriate petition under 37 CFR 1.78. Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at 35 U.S.C. § 120 (and its promulgating regulation 37 CFR 1.78) provides a specific mechanism whereby an applicant may petition the USPTO to correct a priority claim. Since there is a specific mechanism in place to remedy the requested relief then it is inappropriate for the USPTO to contemplate circumventing that mechanism by creating another remedy.

The supplemental oath or declaration filed October 5, 2004 indicates that petitioner may be seeking a benefit claim under 35 U.S.C. 120 of International Application No. PCT/EP/008841 having an international filing date of August 7, 2002. If petitioner desires to claim domestic priority to the PCT application, then a petition under 37 CFR 1.78(a)(3) and the surcharge of \$1,370 must be submitted. Additionally, petitioner must supply either an amendment to the first line of the specification in compliance with 37 CFR 1.121 or an Application Data Sheet referencing the claim for priority to the PCT application in accordance with 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii). The claim for priority to the German application is more appropriately set forth in either the oath/declaration or an Application Data Sheet.

Additionally, the supplemental Application Data Sheet submitted with the instant petition indicates that petitioner may be seeking a benefit claim under 35 U.S.C. 371 of International Application No. PCT/EP/008841 having an international filing date of August 7, 2002. That is, it may be that petitioner is assuming that the above-identified application papers represent the U.S. National Stage Application national stage entry under 35 USC 371 of the aforementioned international application. Petitioner is placed on notice that, as explained in MPEP 1893.03(a), the indicia present herein are that of an application filed under 35 USC 111(a) and are not the indicia of an application filed and processed under 35 USC 371. Since the initially deposited application did not clearly identify the papers as a submission to enter the national stage under 35 U.S.C. 371. See 37 CFR 1.495(g)). As such, the USPTO has treated this application as an application filed under 35 U.S.C. 111(a). See 37 CFR 1.417. Accordingly, the only way that petitioner may seek, in the instant application, to obtain the benefit of the international filing date of the prior international application is to present a proper claim under 35 USC 120 and 37 CFR 1.78(a)(3) of the prior international application, which would specify the relationship as that of continuation or, if appropriate continuation-in-part. Note further that as petitioner did not enter the national stage in the U.S., i.e., this application constitutes a “bypass” of the national stage requirements, petitioner will have to file a certified copy of the priority document, in order to perfect his claim for benefit under 35 USC 119(a) of German 10138888.8 filed August 8, 2001. See MPEP 1895.01, which states in pertinent part:

A foreign priority claim is proper in the continuing application if the foreign application was filed within 12 months prior to the filing of the continuing application or within 12 months prior to the international filing date of the parent international application. In addition, the required claim must be made within the time period set forth in 37 CFR 1.55 (a)(1). This time period is not extendable. See MPEP § 201.14. **A certified copy of any foreign priority document must be provided by the applicant unless the parent international application has entered the national stage under 35 U.S.C. 371 and the national stage application contains a photocopy of the priority document from the International Bureau. See MPEP § 1893.03(c). In such case, the applicant, in the continuing application, may state that the priority document is contained in the national stage application** (emphasis added).

It is noted that petitioner's deposit account currently lacks enough funds to cover all the fees due under 37 CFR 1.78 for fifty-one patent applications. Failure to supply the fees promptly will result in automatic dismissal of all the petitions under 37 CFR 1.78 and further, may raise a question as to whether the delay in supplying a grantable petition is truly unintentional.

With respect to the request to refund the fees in U.S. Patent Application Nos. 10/441,653; 10/771,659; and 10/445,704 such request will not be entertained herein. See 37 CFR 1.4(c).

In view of the above, the decisions on the fifty identical petitions will be held in abeyance for a period of **ONE (1) MONTH** in order to provide petitioner time to consider filing, in each case, a request to withdraw the petitions under 37 CFR 1.183 along with either a proper petition under 37 CFR 1.78(a)(3)

in order to claim domestic priority of the desired International Application or a proper petition under 37 CFR 1.182 in order to convert the application to a National Stage Application filed under 35 U.S.C. 371. At the end of this period decisions will be rendered on the petitions pending in the related fifty patent applications.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application. The Application Data Sheet filed March 20, 2006 fails to properly state the relationship of PCT/EP/008841 to this application.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and a substitute amendment or an Application Data Sheet (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) which state the relationship of the prior-filed application to this application are required.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099 or in his absence, the undersigned at (571) 272-3217.



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